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10/748,542

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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

MAIL DATE

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09/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/748,542 | Applicant(s) FANDEL, RICKEY L. | |
| | Examiner William V. Gilbert | Art Unit 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-14,16,17,19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-9,11-14,17,19,21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a first action following a request for continued examination. Claims 3, 10, 15, 18 and 20 have been cancelled. Claims 1, 2, 4-9, 11-14, 16, 17, 19 and 21-28 are pending, and claims 5 and 16 are withdrawn from consideration. Claims 1, 2, 4, 6-9, 11-14, 17, 19 and 21-28 are examined.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 July 2008 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-9, 11, 12, 22 and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Griswold (U.S. Patent No. 1,794,072).

Claim 1: Griswold discloses a flashing receiver (Fig. 5) comprising a thin gauge material shaped to a first leg (11) and a second leg (15) defining an acute angle at a top of the receiver (as shown in the drawings) the first and second legs are not parallel, the first leg has a height between the top and bottom and forms a mounting face, the second leg has first and second sides associated with a wall covering and removable flashing (7a and member 7 between portions 11 and 15 as shown in Fig. 4, respectively; applicant should respectfully note that the limitation "associated with" provides broad limitation and is not necessarily limited to "being in contact with",) an intermediate member (14) offsetting the first and second legs, and a J-shaped channel (formed with member 18) in the second leg, the channel has a bottom and outer extension (portion 18) that is substantially parallel to an entirety of the height of the first leg (the limitation "substantially parallel" provides flexibility to the interpretation and is not limiting to

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"exactly parallel", as a result, a portion of the channel is substantially parallel with the first leg), the first leg extending at least as far as the bottom of the J-shaped channel (as shown).

Claim 2: the material is metal (page 1, line 80).

Claims 6 and 7: the intermediate member is rigid and resilient (as shown).

Claim 8: the second leg is at an angle to the first leg.

Claim 9: an intermediate portion (18) is at an angle with the first and second legs.

Claim 11: the J-shaped channel is at a height above the bottom.

Claim 12: the channel overlaps a portion of the flashing (as shown).

Claim 22: the outer extension is at a lateral distance from the first leg (as shown) and is a preconfigured distance sufficient to protect roofing components underneath the J-shaped channel.

Claim 24: the language "said J shaped channel is sufficiently wide to receive a bottom of a siding panel" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 25: the first leg extends in a substantially flat plane at least as far as a height of the second leg.

Claim 26: Griswold discloses a flashing receiver comprising a thin gauge material having a first leg and a second leg (11, 15, respectively) defining an acute angle at a top of the receiver (as shown), the first leg and second leg are non-parallel, the first leg having a first extent in a first direction and a longitudinal extent forming a mounting face, the second leg has first and second sides (as shown), the first side is associated with a wall covering (7a) and the second side associated with a removable flashing (7; the portion as shown in Fig. 4 between the first and second legs, see also rejection above for explanation of the interpretation of "associated with"), an intermediate member (14) offsetting the first leg from the second leg, and a J-shaped channel (18) having a bottom and an outer extension that is substantially parallel to an entirety of the first leg (the limitation "substantially parallel" provides flexibility to the interpretation and is not limiting to "exactly parallel", as a result, a portion of the channel is substantially parallel with the first leg) the extent

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of the parallel portion of the first leg extending at least as far as said bottom of the J-shaped channel (as shown).

Claims 27 and 28: the first leg extends beyond the bottom of the J-shaped channel.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 13, 14, 17, 19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griswold.

Claim 4: Griswold discloses the claimed invention including a nail hole (12), but it does not disclose a plurality of nail holes as claimed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of duplication of parts to have this limitation because duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669 (CCPA 1960). See MPEP §2144.04.

Claim 13: Griswold discloses a flashing receiver (Fig. 5) comprising a thin gauge material shaped to have a first leg (11) and a second leg (15) defining therebetween an acute angle at a top of the receiver, the first and second legs are not parallel, the first leg forms a mounting face, at least a portion of the second leg forms a J-shaped channel (formed by portion 18), the second leg has a first side associated with a wall covering (7a) and a second side associated with a removable flashing (7; see rejection above for clarification of the limitation "associated with"), a nail slot (12) extending through the first leg and the second leg (proximate 16) and proximate to said top, an intermediate member (14) offsetting the first leg from the second leg and made of a resilient material (page 1, line 80; it

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is made of metal), the J-shaped channel has an outer extension (proximate 18) substantially parallel with the first leg, the parallel portion extending at least as far as a bottom of the channel. Griswold does not disclose a plurality of nail slots. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of duplication of parts to have this limitation because duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669 (CCPA 1960). See MPEP §2144.04.

Claim 14: the material is metal (page 1, line 80).

Claim 17: the second leg portion is at an angel to the first and second legs.

Claim 19: the J-shaped channel is at a height above the bottom.

Claim 21: the height is a preconfigured distance that would allow roofing components between a bottom of the first leg and a bottom of the channel (as shown).

Claim 23: while the prior art of record does not disclose the preconfigured distance, it would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the dimensions as claimed because applicant failed to state a criticality for the

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necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed.

See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Holmstrom (U.S. Patent No. 2,682,236: see Fig. 3); Gerosa (U.S. Patent No. 1,813,798: see Fig. 1). In addition, please note the following, though these were not used in the rejection due to applicant's claimed limitation of the panel and flashing "in association with" the member (however, the limitation "associated with" has

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a very broad interpretation): Ritchie (U.S. Patent No. 3,150,851), Cortina (U.S. Patent No. 3,351,073; Fig. 3), Philpot (U.S. Patent No. 5,364,051; Fig. 2), Orr (U.S. Patent No. 6,202,969; Fig. 8), Kacines (U.S. Patent No. 6,378,827); Gardner (U.S. Patent No. 2,325,124; Fig. 4), Harbin (U.S. Patent No. 6,883,288, Fig. 5: 64), Butzen (U.S. Patent No. 4,648,218, Fig. 5), Kind (U.S. Patent No. 6,981,682, Fig. 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./
Examiner, Art Unit 3635

/Basil Katcheves/
Primary Examiner, Art Unit 3635